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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MOHAMAD D. SHALATI,
JAMES A. MARQUART,
SANDRA H. ANGELO
and RODNEY M. HARRIS

Appeal No. 94-3393
Application 07/750,146[1]

ON BRIEF

Before JOHN D. SMITH, TURNER and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the primary examiner's rejection of claims 1, 2, 7, 9, 10, 12-25, 28 and 30-40, all of the claims pending in the application.

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[1]Application for patent filed August 26, 1991. According to appellants, the application is a continuation of Application 07/412,355, filed September 25, 1989, now U.S. Patent No. 5,043,220, which is a division of Application 07/120,888, filed November 16, 1987, now U.S. Patent No. 4,871,806.

Claim 1 is illustrative and reads as follows:

1. A curable composition which comprises:

(i) an acid-functional polymer having an average of at least two carboxylic acid groups per molecule and which is selected from the group consisting of acid-functional free radical addition polymers obtained by the polymerization of unsaturated acids and one or more copolymerizable monomers, and acid-functional polyester polymers, with the proviso that the acid-functional polymers are not obtained by the reaction of a hydroxy-functional polymer and a cyclic carboxylic acid anhydride; and

(ii) an anhydride-functional polymer having an average of at least two cyclic carboxylic acid anhydride groups per molecule, wherein the polymer is the addition polymerization reaction product of at least one unsaturated monomer having anhydride functionality and, optionally, at least one other copolymerizable unsaturated monomer; and

(iii) an epoxy-functional compound having an average of at least one epoxy group per molecule; and

(iv) a hydroxy-functional compound having an average of at least two hydroxyl groups per molecule;

with the proviso that none of the acid-functional polymer (i), the anhydride functional polymer (ii), the epoxy functional compound (iii), or the hydroxy functional compound (iv) are identical to each other.

THE REJECTION

Claims 1, 2, 7, 9, 10, 12-25, 28 and 30-40 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification, as originally filed, does not provide adequate written descriptive support for the invention as now claimed.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the examiner's rejection should not be sustained.

Appellants claim a curable composition which includes an acid-functional polymer, an anhydride-functional polymer, an epoxy-functional compound, and a hydroxy-functional compound. The sole issue on appeal is whether the following limitation regarding the acid-functional polymer component, which appears in step (i) of each of appellants' independent claims (claims 1 and 25), is new matter: "with the proviso that the acid-functional polymers are not obtained by the reaction of a hydroxy-functional polymer and a cyclic carboxylic acid anhydride".

This limitation was introduced into the claims in response to an election of species requirement wherein the examiner required appellants to choose an acid-functional polymer selected from a polyester, an acrylic polymer, and a cyclic carboxylic acid anhydride half-esterified with a hydroxy-functional polyester or acrylic polymer (August 3, 1992 Office action, paper no. 4, page 3). Appellants acknowledged that the acid-functional polyester and acrylic polymers were obvious

variants for purposes of the present application, and elected for examination "an acid-functional acrylic or polyester polymer other than the [product of a] half-ester reaction of a polyester or acrylic polyol and an anhydride" (August 3, 1992 Office action, paper no. 4, page 4; February 3, 1993 amendment, paper no. 7, page 6). Appellants amended the claims to expressly exclude acid functional polymers which are "obtained by the reaction of a hydroxy-functional polymer and a cyclic carboxylic acid anhydride" (February 3, 1993 amendment, paper no. 7, pages 2-3).[2]

The examiner's position is that appellants' claims contain new matter because there is no statement in the specification which explicitly excludes acid-functional polymers obtained by the reaction of a hydroxy-functional polymer and a cyclic carboxylic acid anhydride, and because excluding such acid functional polymers is inconsistent with the description on page 5, lines 8-16 of appellants' specification which, according to

[2]Appellants point out that they have already received a patent involving similar curable compositions wherein the acid-functional polymer is obtained by the reaction of a hydroxy-functional polymer and a cyclic carboxylic acid anhydride (brief, page 6; reply brief, page 3). This patent, U.S. 4,871,806, issued from a parent of the present application.

the examiner, "deems a half-ester to be representative" (answer, pages 4-5). Elimination of a species of acid-functional polymer when the specification explicitly recites the suitability of employing it introduces new matter, the examiner argues, because it calls into question which of the species disclosed in the specification "are actually intended to be within the purview of the acid-functional polymer" (answer, page 5).

Appellants' argue that they are merely selecting certain species from a broad patentable genus described in appellants' specification (reply brief, pages 2-3).

We observe that in response to the examiner's new matter rejection, appellants chose not to merely delete the proviso from step (i) of claims 1 and 25. Since the acid-functional polymers included in appellants' claims are limited to the group consisting of (1) acid-functional free radical addition polymers obtained by the polymerization of unsaturated acids and one or more copolymerizable monomers and (2) acid functional polyester polymers, the presence of appellants' proviso suggests that appellants consider some acid functional polymers prepared by reaction of a hydroxy-functional polymer and a cyclic carboxylic acid anhydride, which are excluded from appellants'

claimed invention by the proviso, to be species of the genus "acid-functional free radical addition polymers obtained by the polymerization of unsaturated acids and one or more copolymerizable monomers" or the genus "acid functional polyester polymers" as recited in lines 4-8 of claims 1 and 25. Otherwise, the proviso would serve no purpose in the claims. If (1) acid-functional polyester polymers or acid functional free radical addition polymers obtained by the polymerization of unsaturated acids and one or more copolymerizable monomers, to which appellants' claims are limited, and (2) acid-functional polymers obtained by the reaction of a hydroxy-functional polymer and a cyclic carboxylic acid anhydride, which are excluded from appellants' claims by the proviso, are mutually-exclusive species of "acid-functional polymer", then the proviso places no further limitation on the acid-functional polymers to which the claims are already limited, and therefore is merely superfluous language.

Since the record is not clear as to whether such a species-genus relationship exists, we consider the issue of whether new matter is introduced into an application when a limited genus is formed in a claim by expressly eliminating species from a disclosed genus.

This issue was addressed by the Court of Customs and Patent Appeals in *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). In that case, claim 1 read as follows:

> 1. A substantially linear thermoplastic polyarylene polyether composed of recurring units having the general formula:
>
> -(-O-E-O-E'-)-
>
> where E is the residuum of a dihydric phenol and E' is the residuum of a benzenoid compound having an inert electron withdrawing group in one or more of the positions ortho and para to the valence bonds having a sigma* value above about +0.7, and where both of said residuum [sic, residua] are valently bonded to the ether oxygens through aromatic carbon atoms *with the provisos that E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei.* [Emphasis added.] *Id., 558 F.2d at 1013, 194 USPQ at 191.*

Regarding the subject matter excluded from the claim by the provisos, the court stated:

> The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. All that happened here is that appellants narrowed their claims to avoid having them read on a lost interference count. *Id.*, 558 F.2d at 1019, 194 USPQ at 196.

As for whether the provisos introduced new matter, the court said that "[t]he only inquiry is whether, after exclusion from the original claims of two species specifically disclosed in the 1963 application, the 1963 disclosure satisfies § 112, first paragraph, for the 'limited genus' now claimed." *Id.*, 558 F.2d at 1017-18, 194 USPQ at 195. Based on the facts of the case, the court found such support:

> Here, as we hold on the facts of this case, the "written description" in the 1963 specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining." *Id.*, 558 F.2d at 1019, 194 USPQ at 196.

The court said that appellants were merely excising the invention of another and held that they were not claiming new matter. *Id.*

As in *Johnson*, appellants in the present case are using a proviso to expressly limit their claims so that the claims include only a portion of the whole invention described in the specification. Also as in *Johnson*, appellants' specification describes the limited genus remaining in the claims after exclusion by the proviso of certain species of acid-functional polymers. That is, appellants' specification discloses numerous components for making acid-functional polymers not encompassed by

the proviso which are either acid functional polyester polymers or acid functional free radical addition polymers obtained by the polymerization of unsaturated acids and one or more copolymerizable monomers (page 15, line 10 - page 16, line 5).

Thus, in light of *Johnson*, we find under the facts of the present case that appellants' specification, which describes acid-functional polymers as a whole which are suitable for use in appellants' invention, describes the part remaining after any polymers encompassed by appellants' proviso are excluded. Hence, we find that appellants' specification satisfies the adequate written description requirement of 35 U.S.C. § 112, first paragraph, as to the "limited genus" formed by the proviso.

For the above reasons, we conclude that regardless of whether the acid-functional polymers excluded from appellants' claims by the proviso have a species-genus relationship to the expressly included acid-functional polymers or whether the excluded and included acid-functional polymers are mutually-exclusive species, the acid-functional polymers as recited in appellants' claims have adequate written support in appellants' original specification.

DECISION

The rejection of claims 1, 2, 7, 9, 10, 12-25, 28 and 30-40 under 35 U.S.C. § 112, first paragraph, on the ground that the specification, as originally filed, does not provide support for the invention as now claimed, is reversed.

REVERSED

JOHN D. SMITH
Administrative Patent Judge)

VINCENT D. TURNER
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES

TERRY J. OWENS
Administrative Patent Judge)

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